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MAR 27 2006

OFFICE OF PETITIONS

In re Application of	:
Korber, Stengel, Babcock	:
Application No. 10/616,461	: LETTER AND NOTICE OF
Filed: July 9, 2003	: NON ENTRY OF THIRD PARTY
PG Pub: US20040123782A1 7/2/2004	: PAPERS

This application is before this office due to several documents filed by a third party on February 17, 2006, including (1) a "petition" styled as being filed under 37 CFR 1.1.138(b) to expressly abandon this application which as the issue fee was paid should have been 37 CFR 1.313(c)(3), signed by agent Mary B. Trung Reg. No. 50,007 who is not of record; (2) a purported revocation of the current power of attorney and change of correspondence address by the alleged sole inventor, Stengel, and a purported appointment by Stengel of Trung; and (5) various exhibits that are contended to show that the action taken by Trung on behalf of the alleged sole inventor was proper.

Since this application was the subject of a pre grant publication (PG Pub) prior to the filing of the above-noted documents, the provisions of the statute (35 U.S.C. § 122(c)) the applicable rules (e.g., 37 CFR §§ 1.99, 1.291, and 1.292) and procedures (e.g., MPEP §§ 1134.01, 1901.06) now place stringent limitations on the treatment, or even on the retention *vel non* in this file, of any third party submissions that protest, oppose the grant of, or seek to have other information entered and considered in, this application. See also Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application, 1269 Off. Gaz. Pat. Office 179 (April 22, 2003)

The instant third party attempt to oppose the issuance of a patent to this application appears in the guise of an attempted proceeding under the provisions of 37 CFR 1.33 by the putative sole inventor to unilaterally revoke the power of current counsel, to intervene in the prosecution herein to the exclusion of the other 2 named inventors, revoke the 3 named inventors' freely chosen counsel, appoint his own counsel, change the correspondence address, and permanently prevent the issuance of a patent to this application by way of an express abandonment that would also withdraw this application from issue, and which also entails the consideration of numerous pages of information submitted in support of the proposed action taking.

Under 37 CFR 3.71, the assignee of the entire interest may prosecute an application to the exclusion of the named inventor(s), or any previous assignee, and also revoke, or appoint, a power of attorney in an application or patent. Pursuant to 37 CFR 3.73(b) and MPEP 324, that assignee must present its showing to the Office, either prior to, or concurrently with, the paper that requests the action, and that documentation must be recorded at the USPTO. A party must establish that it is the owner of the entire interest, as the owner of only a part interest in an application does not have the sole right to control prosecution of the application. See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; see also In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (e.g., 37 CFR 3.73(b)) serve to assure that papers filed with the USPTO in an application or patent are submitted on behalf of the owner(s) of the entire interest in the application or patent. See Goldstein, 16 USPQ2d at 1964. Stengel however, does not contend that he is the assignee of the interests of the other named inventors; rather Stengel simply asserts that he is the sole inventor.

Inventorship is the starting point for determining ownership, see University Patents, Inc. v. Kligman, 762 F.Supp. 1212, 1218-19, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991), and unless there is an assignment, the USPTO will presume the named inventor to be the owner. See 37 CFR 3.73(a). Inspection of USPTO assignment records for the instant application fails to reveal that any written instrument has been recorded, or submitted for recordation, against this application, signed by Korber, that conveys his right title and interest herein to any other party, much less to Stengel. On March 3, 2006, the USPTO recorded an assignment of the interest of Babcock to CBT Supply, Inc. at reel 17249, frame 452. Accordingly Korber and Stengel in this application is presumed to retain his *pro rata* ownership interest (33 1/3%) herein. See 37 CFR 3.73(a); Ethicon v. United States Surgical Corp., 135 F.3d 1456, 1460, 45 USPQ2d 1545, 1547 (Fed. Cir. 1998), and CBT is a partial assignee by being the successor in title to Babcock's 33 1/3% interest. It follows that Stengel will not be permitted to unilaterally control the prosecution, much less expressly abandon this application and thus extinguish the interests of the other named inventors. Here, Korber and CBT are the owners of 66 2/3 % of the entire interest in this application and have not consented to the express abandonment of their entire property right in the patent, nor have they given a power of attorney to Trung. Such is sufficient basis for the USPTO to refrain from further processing the papers filed on behalf of Stengel sole. That is, Korber and CBT have a vested property right that can be canceled, revoked, or annulled only by proceedings that afford due process of law. See Iowa State University Research Foundation v. Sperry Rand Corp., 444 F.2d. 406, 410, 170 USPQ 374, 377 (4th Cir. 1971). The USPTO may not permit *ex parte* proceedings before it to extinguish such a property right. See Baker Hughes v. Kirk, 921 F.Supp. 801 (D.D.C. 1995).

It is noted that while the USPTO does not make *ex parte* inventorship determinations, it will consider, *inter partes*, inventorship issues

as part of an interference proceeding (also known as an originality contest, see Sewall v. Walters, 21 F.3d 411, 412, 30 USPQ2d 1356, 1357 (Fed. Cir. 1994)). Rather, when a person believes that he is the inventor of subject matter claimed in the patent or application of another, his remedy is to file an application, if he can, and provoke an interference with the other patent or application. The question of inventorship will then be decided by the Board of Patent Appeals and Interferences based on evidence taken inter partes. In re Cooper, 230 USPQ 638, 639 (Comm'r Pat. 1985); Sewall v. Walters, id.; MPEP 409.03(i).

For the reasons given above, rather than Stengel being the sole inventor who make take action herein unilaterally, Stengel sole is and remains at this time owner of but a one third interest, and under the circumstances of this case is regarded as a third party to the combined interests of the 3 named inventors and the one successor in title . As such, and given the total lack of compliance with either of the two regulations (37 CFR §§ 1.99 and 1.291) governing third party submissions of information in a published application, the documents submitted by the third party on February 6, 2006 cannot be permitted to remain in the file. See MPEP 1901.06 subsection V(a)(2). This communication is also the notice of non entry. See MPEP 1901.06 subsection V(a)(2). The USPTO will not take any further notice of or act on the express abandonment or revocation and power of attorney filed by or on behalf of Stengel sole. These documents are being closed to public inspection which is the IFW equivalent to removal of those documents from a paper file. See MPEP 1901.06 subsection V(a)(2).

Telephone inquiries related to this decision may be addressed to the undersigned at (571) 272-3217.



Brian Hearn
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